PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

ATTORNEY DOCKET NO. 10980726-4

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Winter et al.

Application No.: 10/821,490

Filing Date: 04/09/2004

Confirmation No.: 1425

Examiner: Huntsinger, Peter K.

Group Art Unit: 2625

Title: System and Method for Printing and Scanning a User-Completed Digital Still Camera Image Proof Sheet and Order Form

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 09/22/08 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450

Date of Deposit:

OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.

Date of facsimile: 11/13/08

Typed Name: JoAnn Sismilich

Signature: JAnn Sismilich

Respectfully submitted,

Winter et al.

By _____

Robert C. Sismilich

Attorney/Agent for Applicant(s)

Reg No. : 41,314

Date : 11/13/08

Telephone : (941) 677-6015

Rev 10/08 (ReplyBrf)

HP Docket No. 10980726-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:10/821,490
Conf. No.	:1425
Appellant	:Winter et al.
Filed	:04/09/2004
Title	:System and Method for Printing and Scanning a User-Completed Digital Still Camera Image Proof Sheet and Order Form
TC / Art Unit	:2625
Examiner	:Huntsinger, Peter K.
Docket No.	:10980726-4
Customer No.	:022879

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

This Reply Brief is presented in opposition to the Examiner's Answer mailed 09/22/2008. Appellants are appealing from the Final Rejection of claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131.

I. STATUS OF CLAIMS

The Examiner is correct that claim 71 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims..

II. ARGUMENT

The Examiner's Answer includes a "Response to Arguments" section at p.30-37. In that section, the Examiner presents responses a.-i. to various ones of the arguments presented in the Appeal Brief. The present section of the Reply Brief follows the outline structure used in the Appeal Brief, and cross-references the Examiner's responses a.-i. to the headings, sub-headings, and sub-sub-headings of the outline structure.

Note that, within the outline structure, Appellants present only counterarguments to the specific arguments in the Examiner's Answer. Therefore, please refer to the Appellants' Appeal Brief for additional arguments and for further detail omitted herein.

Before presenting specific counterarguments to the arguments in the Examiner's Answer, Appellants believe it is important to step back from the individual elements of the claims, and look at how drastically different from the cited references the invention is as a whole. The primary reference, Hicks, is directed to the operations of a full-scale photographic laboratory. This photographic lab utilizes a large number of different pieces of equipment - silver halide film developing equipment, computers, scanners, mechanical printing equipment, as well as chemical and optical photographic print production equipment. The photographic lab is the physical plant of a business that produces photographic print packages for institutional groups such as school children, church congregations, clubs and other organizations (Hicks, col. 1, lines 10-13). There are probably a large number of different photographers, who may or may not be employees of the photographic lab, who take the photographs of these various institutional groups, and funnel them into the photo lab for processing. The lab undoubtedly requires a significant film library system to store the large quantity of film negatives after processing but before print orders are received, and a customer tracking system to manage and track the proofs and order forms mailed out to the various individual school children, church members, and club members. Lots of manual activities are involved: moving forms from printer to printer, storing film images for later retrieval, mailing out order forms to potential customers, receiving them back in the mail, scanning them or entering their data manually, retrieving the film images, and using the

retrieved films to make prints. Secondary references are cited by the Examiner for specific claim limitations, but none of them teach or suggest changing the photographic lab in a fundamental way. The Yamaguchi reference, for example, also discloses a large, complex system used in a photographic lab, and which produces traditional wet-chemistry photographic prints on photographic paper (Yamaguchi, col. 11, ln. 23-60).

When Appellants have invented is so very different. With Appellants' invention, an individual photographer with a digital still camera can, for example, insert a memory card from the camera into a slot in his personal printer in his home, after which the printer will generate a combination proof sheet and order form showing the various images on the memory card. The user marks on the printed form which images he would like printed, and how he would like them printed. He then reinserts the marked proof sheet and order form back into his printer. That's all he has to do. The markings he made on the proof sheet and order form are automatically detected by the printer, and the prints he desires are automatically printed out for him on his printer in the manner requested.

Advantageously, the photographer can obtain the prints he desires almost immediately, avoiding the multiple day delays associated with communicating with a laboratory through the mail. The photographer does not need to devote time and resources to assembling a lab's worth of various photographic devices to select and print photos in this manner. He does not need to perform the many steps done in the photo lab to obtain his final prints. The operation of identifying and selecting photos to be printed, and printing them in the form he desires, is incredibly simple, fast, and easy compared to the systems and methods taught or suggested by the references cited by the Examiner in the rejection on Appeal.

A. Claims 43-44, 47-52, 54-57, 61-62, 64-65, 68, 70, and 72 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi").

1. The cited references, alone or in combination, do not teach or suggest all

the limitations of Appellants' independent claim 43.

a) **The feature of a digital print mechanism that generates on a print medium a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image and a plurality of user designation areas is absent from the combined references.**

The following counterargument responds to argument "a." of the Examiner's Answer.

The Examiner argues that the Hicks reference "discloses that the graphical representation are printed simultaneously with the printing of the order form ... the order form can be printed in the same manner as the graphical representation by using a previously prepared photographic negative image" (Examiner's Answer, p.31). The print medium is a contact sheet.

However, Appellants disagree that the photographically-printed contact sheet of the Hicks reference is a combination proof sheet and order form, as understood with reference to the claim as a whole. Considering the claim as a whole, it recites that program logic interprets the user designation areas completed by the user on the sheet and that are detected by a scanner mechanism, and then the digital print mechanism automatically generates at least one final print sheet of at least one of the digitally stored images in accordance with the user designation areas that were completed by the user. In other words, the combination proof sheet and order form produced by the printer mechanism must be capable of supporting this operation by the program logic.

Unfortunately, the photographically-printed contact sheet of this Hicks reference cannot do so. It cannot do so because there is no scanable feature on the contact sheet that can identify which digitally stored image is associated with a particular user-completed user designation area. This identification data is not produced by the contact sheet "printing"mechanism. Rather, it is added to the contact sheet by a different, additional printer in a subsequent step:

"the group code, frame number and composition data are now imprinted on the proof paper using a mechanical or character printer mechanism programmed by group code, frame number, and composition data stored in the computer data base. Group code and frame

number data 28 are shown in FIG. 2 above each proof print and the composition data 30 is shown in FIG. 2 on the lower portion of each proof print. The combined print and order form 14 is now delivered to the subject" (Hicks, col. 3, ln. 37-47; emphasis added)

After the user has marked the combination proof sheet and order form as desired and returned it to the photo processor:

"Upon receipt of the envelope containing the print and order form and payment (and as seen in block 9 of FIG. 1) an operator at the photographic lab enters order data into the computer data base 12 corresponding to the packages selected of each proof print by the subject. Alternatively, the marks made on the order form 26 by the subject may be machine readable in which case the order data from the order forms may be automatically entered into the computer data base by passing the combined print and order form through a suitable read device. Thereafter, as seen in block 10, the identifying data, the order data, and the composition data are supplied from the computer data base and are utilized to produce the final photographic prints." (Hicks, col. 4, ln. 16-30; emphasis added)

As disclosed by the above portions of the Hicks reference, the identifying data of at least the group code and the frame number are needed to locate the desired negative, and then to produce the prints requested by the user on the marked combination proof sheet and order form. Thus two different print mechanisms, at least one of which is not digital, are needed in the Hicks reference in order to generate a combination proof sheet and order form as recited in the claims.

With regard to the Yamaguchi reference, the Examiner states that it "discloses a digital print mechanism" (Examiner's Answer, p.31). Regardless of whether the Examiner is correct, however, the Yamaguchi reference does not teach or suggest a digital print mechanism, or any print mechanism, that generates a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas, as recited in the claim. The Yamaguchi reference does not teach or suggest the printing of any combination proof sheet and order form at all. The printer of the Yamaguchi reference only produces final photographic prints that each correspond to single, individual negatives. Furthermore, no combination proof and order sheet is used in the Yamaguchi reference to instruct the print mechanism for which images the user desires to produce final print sheets. Instead, whatever printing instructions are needed are supplied via a keyboard by an operator who views the image on a monitor (Yamaguchi, col. 11, ln. 1-8).

b) The feature that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets, is absent from the combined references.

The following counterargument responds to argument "b." of the Examiner's Answer.

The Examiner argues that the "mechanical or character" printer mechanism (Hicks, col. 3, ln. 37-45) generates a combination proof and order sheet. The Examiner also argues that the Hicks reference discloses printing the final print sheets as photographic prints (Hicks, col. 4, ln. 27-35) (Examiner's Answer, p.31). However, Appellants note that the mechanical or character printer mechanism cannot produce the photographic prints.

The Examiner further argues that the Yamaguchi reference discloses a digital print mechanism that generates a final print sheet and that also scans, and that it would have been obvious to a person of ordinary skill in the art to combine the references so as to result in "the printer of Hicks '387 producing the final print sheets in addition to printing the combination proof sheet and order form" (Examiner's Answer, p.31-32).

Appellants disagree. As discussed above with reference to the Examiner's argument "a.", the Yamaguchi reference does not teach or suggest the printing of any combination proof sheet and order form at all. Because the Hicks reference teaches that two different printers print the combination proof sheet and order form and the final prints, and because the Yamaguchi reference does not print any combination proof sheet and order form at all, the only source for such teachings is Appellants' claims and specification. This aspect of the rejection relies on impermissible hindsight by the Examiner using Appellants' teachings as a blueprint.

In addition, even if - arguendo, and which Appellants do not concede – the combined references did teach or suggest a single printer that could print both the combination proof sheet and order form and the final prints, the Hicks reference does not teach or suggest that it would use the same printer to print both items in its photographic laboratory. The photo lab that the Hicks reference discloses is a commercial enterprise with a well-defined process flow

for receiving film, proofing, soliciting customer orders, receiving customer orders, and producing final prints. The Hicks reference discloses that the lab uses different equipment to print the combination proof sheet and order form and the final prints. There is no suggestion of any benefits that would accrue from having a single printer that performs both operations. On the contrary, sharing a single printer would involve additional scheduling overhead to determine which operations would be performed when, or to separate mixed output of contact sheets and final prints. Furthermore, if the volume of the order forms and final prints produced by the lab require more than one printer, it would be more cost-effective to produce the final prints using the simpler, conventional photographic print equipment of the Hicks reference rather than the more complex (film to digital to wet-chemistry photographic print), and thus more expensive, printer of the Yamaguchi reference.

c) The feature that the digital print mechanism automatically generates the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user is absent from the combined references.

The following counterargument responds to argument "c." of the Examiner's Answer.

The Examiner argues that the Hicks reference "discloses that the order forms may be automatically entered by entering through a read device ... and thereafter the data is supplied from the computer data based |sic| and utilized to product the final photographic prints. The applicant's specification does not define the term 'automatically'. The definition within the art is 'largely or wholly involuntary'. The generation of the final print sheets is largely or wholly involuntary and therefore can be considered automatic" (Examiner's Answer, p.32)

Appellants disagree.

First, the same portions of the Hicks reference cited by the Examiner above have been extensively argued by Appellants in the Appeal Brief (p.15-16). In the Hicks reference, no final print are produced in response to the detection and interpretation of data on the combination proof sheet and order form. The only operation that is automatically performed

in response to this is that the order data is entered into the computer data base. Only at some time "thereafter" is the order data supplied from the data base and used to produce the final prints. Such prints cannot be produced automatically because the images are not digitally stored images but rather are film images, which must be physically retrieved from a physical storage location based on the group code and frame number stored in the data base and fed into the photographic printer.

Even assuming, arguendo, that the Examiner is correct in his definition of the term "automatically", it strains credulity to consider the above process, particularly the physical retrieval of the films, to be "largely or wholly involuntary" in the photographic lab system and process disclosed by the Hicks reference.

Furthermore, the meaning of term "automatically" is clearly described in Appellants' specification:

"The completed proof sheet and order form 22 is then manually re-inserted into the input/output media tray 38 (FIG. 2) of the ink jet printer 14. ... [T]he printer 14 can detect the re-insertion of the order form 22 and automatically start printing the final print sheet(s). A scanner 46 (FIG. 2) including circuitry and software is mounted in the ink jet printer 14. The scanner 46 ... can incorporate the exiting paper edge sensors that are already in some printer [sic]. Some ink jest [sic] printers have sensors for detecting the type of media and the activation energy for the ink jet pen. These sensors can be used to detect completed user designation areas. The scanner 46 is used to detect the user designation areas completed by the user on the proof sheet and order form 22. This information is conveyed to the CPU 26 for storage in the RAM 30. Programming stored in the ROM 28 is used by the CPU 26 to generate at least one final print sheet 48. ... [T]he final print sheet or sheets have the images and enhancements (e.g. size, cropping, brightness, etc.) designated by the user on the combination proof sheet and order form 22." (Specification, p.8, ln. 5-20; emphasis added)

Thus once the completed proof sheet and order form is inserted into the printer, the desired final print sheet(s) are printed automatically. Nothing like this is either disclosed by the Hicks reference, or taught or suggested by the cited references in combination.

3. The Hicks and Yamaguchi references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the functions that are to be combined,

because it is uncertain whether image quality is improved by the combination, and because of level of ordinary skill in the art has not been established.

The following counterargument responds to argument "d." of the Examiner's Answer.

With regard to the motivation to combine the Hicks and Yamaguchi references, the Examiner argues that it would have been "to provide a user with scanning, digital photo printing, and document printing capability from one device and to improve image quality" (Examiner's Answer, p.33)

Appellants disagree. As has been argued above with reference to the Examiner's argument "b.", the Hicks reference does not teach or suggest the feasibility or the desirability in a commercial photographic lab of using one device to perform all these functions.

In addition, as has been argued in the Appeal Brief (p.19-20), any improvement in gray balance that may have been provided by the teachings of the Yamaguchi reference in 1998 would have come at the cost of degraded image quality due to the multigenerational film image - to digital image - to light projected onto photographic paper printing process taught by the Yamaguchi reference. Furthermore, photographic laboratories like that of the Hicks reference already employed alternate methods during the printing process to achieve proper color balance, such as color filters. So there is no evidence that prints produced by the printer of the Yamaguchi reference would have any better gray balance than prints produced by the lab of the Hicks reference. Any such improvement is merely speculatory.

Furthermore, the Examiner is asserting what a person of ordinary skill in the art would find obvious, without providing any evidence that resolves or specifically defines the level of ordinary skill in the pertinent art. Resolving the level of ordinary skill in the art is a required element of an obviousness rejection, because "the [Graham v. Deere] factors continue to define the inquiry that controls" *KSR Int'l Co. v. Teleflex Inc., 82 USPQ2d 1385, 1387 (S.Ct. 2007)*. Without such evidence, the level of ordinary skill in the pertinent art can be defined only by the cited references themselves. And as has been discussed previously, the references themselves do not teach or suggest the modifications proposed by the Examiner.

D. Claims 74-76, 79-82, and 84 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz").

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 74.

b) The feature of automatically enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas is absent from the combined references.

The following counterargument responds to argument "e." of the Examiner's Answer.

The Examiner argues that the Bartz reference "reads the exposure parameter (i.e. detecting and interpreting the completed user designation areas), records the data into storage and generates control commands to automatically control the transparency exposure to the printer (i.e. enhancing the digitally stored image)" (Examiner's Answer, p.34).

To whatever extent, if any, that the Examiner's characterization of the Bartz reference may, arguendo, be correct, Appellants contend that the Bartz reference does not teach enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas, as recited in claim 74. As argued in the Appeal Brief (p.28-30), the generation of commands to the printer of the Bartz reference to automatically control the exposure is not performed responsive to detecting and interpreting the completed user designation areas (i.e. mark box column 18 and 19 of table 17). Instead, the marks made by a user in mark box columns 18 and 19 are read by an optical character reader, and data corresponding to the user marks is stored in data blocks on the magnetic strip 20 of the masking card carrying the corresponding negative. This operation must be performed prior to enhancing the image. What occurs responsive to the detecting and interpreting of the marks in the mark boxes by the optical character reader is only that the data is stored in the data blocks of the magnetic strip 20.

In the rejection, the Examiner incorrectly equates exposing the negative on the

masking card to enhancing a digitally stored image, a characterization with which Appellants disagree. However, even if, arguendo, the Examiner's position in this regard is correct, the film or negative on the masking card is not exposed responsive to the detecting and interpreting of the marks in the mark boxes. Instead, the masking card on which the exposure parameters are stored in the magnetic strip 20 after the optical scanning of the marks has been completed, may (or may not) be eventually input to the photo printer in a subsequent operation for printing an image of the film or negative carried by the masking card. The Bartz reference clearly teaches that this is done in a subsequent operation, because it discloses that the masking cards can be supplied to the photo printer in any desired sequence. Thus any automatic enhancing of an image is not performed responsive to the detecting and interpreting of completed user designation areas (i.e. the marks in the mark boxes).

3. The Hicks and Bartz references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the features disclosed only in Appellants' invention, and because of level of ordinary skill in the art has not been established.

The following counterargument responds to argument "f." of the Examiner's Answer.

The Examiner argues the previously stated motivation of allowing the user to crop and choose the color of ordered prints (Examiner's Answer, p.35). Appellants disagree, for similar reasons as argued in the Appeal Brief (p.31).

The Examiner also argues that the Bartz reference "teaches that automatic control of printer parameters alleviates the time consuming operation of manually entering parameters" (Examiner's Answer, p.35). However, this would not provide motivation for combining with the Hicks reference, since the Hicks reference already discloses that the marks on the order form may be automatically entered into the computer data base (Hicks, col. 4, ln. 21-26). The Bartz reference adds nothing to the Hicks reference in this regard, and hence the reason does not have a rational underpinning.

Furthermore, the Examiner is asserting what a person of ordinary skill in the art would find obvious, without providing any evidence that resolves or specifically defines the level of ordinary skill in the pertinent art. Resolving the level of ordinary skill in the art is a required element of an obviousness rejection, because "the [Graham v. Deere] factors continue to define the inquiry that controls" *KSR Int'l Co. v. Teleflex Inc., 82 USPQ2d 1385, 1387 (S.Ct. 2007)*. Without such evidence, the level of ordinary skill in the pertinent art can be defined only by the cited references themselves. And as has been discussed previously, the references themselves do not teach or suggest the modifications proposed by the Examiner.

4. There is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Hicks and Bartz references would produce a seemingly inoperative device that could not properly produce final prints from order information or from image information on the form.

The following counterargument responds to argument "g." of the Examiner's Answer.

In the Appeal Brief (p.32-33), the Appellants argued why the combination of the Hicks and Bartz references would produce a seemingly inoperative device that could not properly produce final prints from order information or from image information on the form. The Examiner has not directly addressed the substance of these arguments, other than to assert that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary invention", but "what the combined teachings would have suggested to those of ordinary skill in the art" (Examiner's Answer, p.36). However, as has already been explained, what the combined teachings would have suggested to those of ordinary skill in the art cannot be ascertained without first providing evidence that resolves or specifically defines the level of ordinary skill in the pertinent art. Without such evidence, the level of ordinary skill in the pertinent art can be defined only by the cited references themselves. And also as has been discussed previously, the references themselves do not teach or suggest the modifications proposed by the Examiner.

Furthermore, Appellants contend that because combining the reference teachings as

suggested by the Examiner would result in an inoperative device, one of ordinary skill in the art would not have made such a combination in any case. In other words, the Hicks reference would have taught away from combination with the Bartz reference.

E. **Claim 40 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz").**

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' dependent claim 40.

a) **The feature that the user designation cropping areas are markable by the user to graphically indicate two-dimensional cropping positions for the image is absent from the combined references.**

The following counterargument responds to argument "h." of the Examiner's Answer.

In the Appeal Brief (p. 35-36), Appellants argued that the combined references, and specifically the mark box columns 18,19 of the Bartz reference, do not graphically indicate the two-dimensional cropping positions for the image. In the Examiner's Answer (p.36-37), the Examiner fails to point out how any of the references graphically indicate the two-dimensional cropping positions for the image. The examples cited by the Examiner, such as the a percentage or a print size, do not graphically indicate two-dimensional cropping positions. Thus, Appellants reemphasize the arguments presented in the Appeal Brief in this regard.

Q. Claim 77 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz"), and further in view of U.S. Patent No. 6,181,409 to Calhoun ("Calhoun").

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' dependent claim 77.

a) The feature that the form has a plurality of graphical representations of the digitally stored image, each graphical representation prospectively indicative of the effect of the enhancement is absent from the combined references.

The following counterargument responds to argument "i." of the Examiner's Answer.

The Examiner argues that "bar code 80 contains instructions for separating the images from one another and therefore each graphical representation is prospectively indicative of the effect of the enhancement".

First, the Examiner is apparently arguing that the bar code is the graphical representation. However, the bar code is not a graphical representation of the digitally stored image, as required by the claim; these images would be images 62 or images 70. Rather, bar code 80 is a machine-readable bar code that may contain printer instructions as to information that is to be printed on the back side of the photos, or locations for cutting the photos (Calhoun, col. 6, ln. 9-29). Furthermore, there is no indication that the bar code is a digitally-stored image at all; rather, the bar code image is generated only when it is printed, as a way to represent the underlying instructions or locations, with the instructions or locations encoded into a bar code during the printing process.

In addition, the "enhancement" is recited, in base claim 74, as "a particular image enhancement applicable to an image". In other words, each graphical representation prospectively indicates what the effect of the enhancement to the digitally stored image will be, if the enhancement is subsequently made to the image. If bar code 80 of the Calhoun reference is considered to be the graphical representation, it does not indicate how bar code

80 might appear after its image is enhanced. Some such enhancements might even cause bar code 80 to fail to be recognized and decoded.

Finally, it stretches credulity to argue, as the Examiner apparently does, that instructions for where to cut the individual printed images printed on a web could be an "image enhancement" of any type.

III. CONCLUSION

Appellants contend that claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131 were improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations, there is no articulated reason with some rational underpinning to modify or combine reference teachings, and/or there is no reasonable expectation of success in combining the references. Such a suggestion or motivation could be found only in hindsight and in light of Appellants' teachings.

Each of these reasons alone distinguishes Appellants' claims from the cited references and makes Appellants' claims non-obvious in light of the cited references.

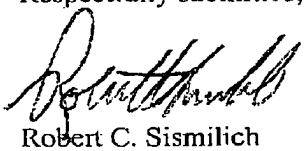
Overruling of the Examiner's rejections of claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131 is respectfully requested.

HP Docket No. 10980726-4

AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich
Reg. No. 41,314
Attorney for Appellant(s)
Telephone: (941) 677-6015

Date: 11/13/08

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400